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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,333	09/11/2003	Francesco Valentini	38117/GM/lp	3784

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,333

Applicant(s)

VALENTINI, FRANCESCO

Examiner

Anthony Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01122004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornell 4,991,318. Cornell '318 discloses all the limitations of the claims including the following: a protection comprising a sheath 50 that can be applied to the tip of a shoe (see col. 2, lines 64-68); removable retention elements 66 to prevent disengagement from the shoe; the sheath is open in a downward region (see Figure 2) and has an upper portion 80 and a perimetric portion (48, 50) which is connected to the upper portion and is substantially perpendicular thereto (see Figures 2-3).
3. Claims 1, 3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by McArthur, Sr. et al. 4,780,970. McArthur, Sr. et al. '970 discloses all the limitations of the claims including the following: a protection 10 comprising a sheath 12 that can be applied to the tip of a shoe (see Figure 1); removable retention elements 26 to prevent disengagement from the shoe; the sheath made of elastically flexible synthetic material (styrene butadiene rubber, col. 2, line 45); the sheath is made of rubber material (col. 2, line 45).
4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Despres et al. 5,711,092. Despres et al. '092 discloses all the limitations of the claim including the following: a

protection comprising a sheath 14 that can be applied to the tip of a shoe (see Figures 1-3);
removable retention elements 28 to prevent disengagement from the shoe

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell 4,991,318 as applied to claim 2 above in view of Hung 6,131,312. Cornell '318 as applied to claim 2 above discloses all the limitations of the claims including the band made of elastically extendible material and having two ends (see Figures) with the ends fixed in respective lateral openings 64 in the cover. Cornell '318 does not teach the band engaging under the sole and the rivets being located under the openings. Hung '312 teaches that the strap for holding a bottom opened cap on a shoe can extend under the sole of the shoe (as seen in Figures 2 and 5-9) to help hold the cap firmly onto the top of the shoe. Hung '312 further teaches that fastening means (equivalent to rivets, clips located on strap ends) can be located below the openings (see Figure 2) to fasten the ends of the straps and prevent the accidental release of the strap during use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the strap of Cornell '318 extend under the sole, as taught by Hung '312, to help firmly hold the cap on top of the shoe while allowing the fastening means to be located below the openings to fasten the ends of the straps passing through the openings.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McArthur, Sr. et al. 4,780,970 as applied to claim 3 above in view of March 6,584,704. McArthur, Sr. et al. '970 as applied to claim 3 above discloses all the limitations of the claim except for the material being substantially transparent. March '704 teaches that material used for covering a shoe upper can be transparent to allow for the color and style of the shoe to show through the cover. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the cover of McArthur, Sr. et al. '704 out of transparent material, as taught by March '704, to allow for the style of the shoe to be shown through the cover.

8. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell 4,991,318 as applied to claim 2 above in view of Damron 4,051,612. Cornell '318 discloses all the limitations of the claims except for the retention means having two hooks associated with the perimetric portion and suitable to lock the sheath onto the shoe, engaging under the sole and the hooks being right-angled fold with the hooks being part of the perimetric portion. Damron '612 teaches that the perimetric portion of the shoe toe cover can contain hooks 24S that attach to the sole portion of the shoe to help hold the cover onto the shoe. Therefore, it would have been obvious, to place hooks, such as those taught by Damron '612, on the perimeter of the cover of Cornell '318 to aid in holding the open bottomed cover onto the shoe.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell 4,991,318 as applied to claim 2 above in view of Despres et al. 5,711,092. Cornell '318 as applied to claim 2 above discloses all the limitations of the claims except for the lower portion of the perimetric portion having holes for studs to pass through to help hold the cover onto the user's shoe. Despres et al. '092 teaches that the portion of the shoe cover that extends under the shoe

Application/Control Number: ~~10/659,333~~
Art Unit: 3728

Page 5

can have holes for cleats to pass through and help in holding the cover onto the user's shoe. Therefore, it would have been obvious, for one of ordinary skill in the art at the time the invention was made, to place hole in the portion of the cover of Cornell '318 that extends under the sole for the shoe, to aid in holding the cover onto the user's shoe.

Allowable Subject Matter

10. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

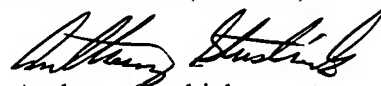
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: ~~10/659,333~~
Art Unit: 3728

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS